

REMARKS

The last Office Action of February 24, 2003 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1, 3, 6, 7, 9 and 12-17 are pending in the application. No claims have been amended or canceled.

Claims 1, 3, 6, 7, 14, 15 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,787,680 (hereinafter "Bonjean et al") in view of U.S. Pat. No. 4,582,259 (hereinafter "Hoover et al."), Metals Handbook Vol. 1 and ASM Handbook Vol. 5.

Claims 9, 12, 13 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bonjean et al in view of Hoover et al.), ASM Handbook Vol. 4 and ASM Handbook Vol. 5.

Applicants respectfully disagree with the Examiner's rejection of the claims under 35 U.S.C. 103(a) for the following reasons:

The present invention is directed to a process to produce a particular element in a twist beam axle for motor vehicles, namely a torsionally-yielding profiled member with rigid end sections, whereby a particular focus is directed to the properties of the transition between the midsection of the profiled member and the end sections thereof. During the telephone interview conducted with the Examiner on January 14, 2003, the Examiner acknowledged his failure to properly appreciate the relevancy of the steps relating to the production of these transitional

sections of the profiled member and, as a result, withdrew the rejection of the claims on the basis of the Toepker et al. reference.

The Examiner now based the rejection of the claims on a total of four references to make a case of obviousness. In general, applicants wish to note that it is well established that identification of each claimed element in the prior art is not sufficient to negate patentability. Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability. *In re Rouffet*, 47 USPQ2d, 1453, 1457 (CAFC). It is applicants' contention that it is precisely this approach that the Examiner has taken to negate patentability.

The Bonjean et al. reference is directed to a U-shaped semi-rigid axle for a vehicle and a method thereof, whereby a metal tubing is formed into a U-shaped configuration to define a central portion and an axle arm portion at each end thereof, and part of the central portion is deformed to include a rectilinear section. In order to enhance mechanical characteristics, total or localized heat treatment may be appropriate. It is applicants' assessment that the Examiner failed to fully appreciate the subject matter, as set forth in claims 1 and 9. As stated above, an essential feature of the present invention is the implementation of the transitional sections, designated by reference character (b) in Fig. 1 of the instant specification, and the combination of the method steps. Please note that claims 1 and 9 do not claim a heat treatment per se but claim a combination of method

steps to realize a profiled member with particular characteristics, whereby the annealing step with respect to the transitional sections at the particularly defined temperature range is relevant here.

The Examiner noted that Bonjean et al. fails to teach i.a. a cold-forming step, an annealing step, a tempering step and an outer surface hardening step. Thus, not only is Bonjean et al. silent as far as the relevant method steps of claims 1 and 9 is concerned, Bonjean et al. also fails to make any reference to the crucial areas of the transitional sections. In fact, also the Examiner fails to make any reference to the transitional sections, but merely applies general teaching that is described in Handbook Vol. 1 or Handbook Vol. 4 or Handbook Vol. 5. Again, applicants wish to emphasize, that claim 1 sets forth particular steps (cold forming a tube blank to a profiled member; annealing transitional sections at a temperature level between 850 °C and 960 °C, hardening above the AC3 point, tempering, outer surface hardening), and claim 9 sets forth particular steps (cold forming a tube blank to a profiled member; case-hardening transitional sections, outer surface hardening), to produce a particular product (tubular profiled member for a twist beam rear axle) with particular characteristics (bending-resistant, torsionally yielding). While individual method steps may be known in the prior art, it is the combination that applicants are desirous to protect.

An indication that the Examiner does not fully appreciate the subject matter of the present invention, and simply made an attempt to pick individual features from the prior art to produce the present invention, is the reference to the Hoover et al. patent. Hoover et al. is directed to a method of forming a spray nozzle along

a fluid conduit. It is applicants' belief that a person skilled in the art of twist beam rear axles of motor vehicles, as the present invention is directed to, would not consider a reference that relates to spray nozzles, and combine them. There must be some motivation to combine the references to create the case of obviousness, and a showing that a skilled artisan, confronted with the problems as the inventor, would select the elements from the cited prior art references. It is applicant's contention, that the Examiner failed to explain the motivation one with no knowledge of applicant's invention would have to combine the references in a manner suggested.

For the reasons set forth above, it is applicant's contention that neither Bonjean et al. nor Hoover et al, nor Handbook Vol. 1, nor Handbook Vol. 4, Handbook Vol. 5, nor any combination thereof teaches or suggests the features of the present invention, as recited in claims 1 and 9.

As for the rejection of the retained dependent claims, these claims depend on claims 1 and 9, respectively, share their presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the newly submitted claims. It is thus felt that no specific discussion thereof is necessary.

Applicant believes that when the Examiner reconsiders the claims in the light of the above comments, he will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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